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NIXON PEABODY LLP 161 N CLARK ST. 48TH FLOOR CHICAGO, IL 60601-3213				
			EXAMINER HOEL, MATTHEW D	
			ART UNIT 3714	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 09/992,392	Applicant(s) LOCKE ET AL.	
	Examiner Matthew D. Hoel	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/15/2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,17-29,31,33 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17-29,31,33 and 38-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 4, 5, 7, 9 to 12, 14, 18 to 20, 22, 24 to 28, 31, and 38 to 40 are rejected under 35 U.S.C. 103(a) as being obvious over Yoseloff, et al. (U.S. patent 6,464,581 B1) in view of Markowicz, et al. (U.S. patent 5,938,200 A).

4. As to Claim 1: '581 discloses all of the limitations of Claim 1, but lacks specificity as to at least one of the reels comprising a video reel and wherein the processor is operable, for at least one of the reels, to move a selected discrete symbol relative to the continuous graphical element independent of player control to determine an award corresponding to the randomly determined outcome, the award being related to a degree of the movement and being independent of any payline. '581 teaches a slot

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machine comprising a plurality of reels, each of the reels comprising a reel strip bearing a plurality of discrete symbols and a continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element (Abst.; simulated movie reel, Fig. 3; looping reels, Fig. 8; Col. 2, Lines 30 to 56). '581 teaches a processor operable to rotate the reels and stop the reels to place the discrete symbols in visual association with a display area (Col. 9, Lines 44 to 48; Col. 9, Lines 9 to 18; 1 to 5 frames exposed for active play, Abst.). '581 awards a payout responsive to an alignment of a plurality of discrete symbols associated with a winning combination along a selected payline (Col. 4, Line 65 to Col. 5, Line 9). '200, however, teaches at least one of the reels comprising a video reel and wherein the processor is operable, for at least one of the reels, to move a selected discrete symbol relative to the continuous graphical element independent of player control to determine an award corresponding to the randomly determined outcome, the award being related to a degree of the movement and being independent of any payline. '200 in Figs. 1 and 2 discloses a video display with a plurality of video reels. The reels are continuous graphical elements in that they are rows of squares on a board, analogous to the individual film frames on the film reels of '581 Figs. 2 & 3. They are also a continuous graphical element in the same sense as the applicants' own Monopoly embodiment as discussed on Pages 4 and 5 of the office action of 5/18/2006, and so anticipate this limitation. As each drawing element of '200 is drawn, the game participant moves one space forward and the player who reaches the finish line first wins, so the award is independent of player control and is related to the degree of

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movement (Abst.; player can make various bets based on which participant is first, second, and third, Fig. 3, so this is relative speed or degree of movement; Fig. 6; 3:63-67, 4:3-5, 4:13-21, 4:26-29, 4:47-54, 4:63-65, 5:1-8). The award is independent of any payline as it is based on who reaches the termination point first. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the award related to a degree of movement and independent of player control or a payline of '200 to the gaming device of '581. In the Fig. 5 embodiment of '581 (Fig. 5, 7:63-67), there are vehicles, in this case train cars, moving relative to the continuous graphical element, as in '200. The random stopping of the cars in '200 is somewhat analogous to the random stopping of the train cars in '581 7:63-67, as it is not certain which car will stop where in either game. Some motivation for combination can be found in the prior art generally. Okada in U.S. patent 4,889,339 A teaches stopping slot reels in a random order (3:53-4:7). The cars on the course of '200 Fig. 2 could be thought of as symbols on a slot machine coming to the finish line or stopping (36 Fig. 2, which is acting as a payline in this case) at random times. The obviousness of symbols moving along a continuous graphical element in which the outcome is independent of player input and any payline, is demonstrated in that games like '200 are merely an automation of dice games in which players proceed a certain number of squares based on the roll of the dice and the player to reach the finish first wins (in re Venner, MPEP 2144.04 (III); Telarico, et al., U.S. patent 5,934,673 A, generally, particularly Abst. & Fig. 1). '200 moves players a fixed number of spaces in random order and '673 moves players a random number of spaces in fixed order, but game play is otherwise basically

the same, as the players are awarded based on who reaches the finish line first. The advantage and effect of this modification is that the bonus game provided by '200 matches the vehicle embodiment of '581 and to provide an award to the player which is easy to visualize without referring to a paytable as the award based on the degree of relative motion is readily visible to the player and is easy to relate to.

5. As to Claim 9: '581 teaches a slot machine comprising a plurality of reels, each of the reels comprising a reel strip bearing a plurality of discrete symbols positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbols positions are thematically unified by the graphical element, each of the reels strips also bearing a discrete symbol in at least one of the discrete symbol positions (Abst.; simulated movie reel, Fig. 3; looping reels, Fig. 8; Col. 2, Lines 30 to 56). '581 has a processor programmed to award a payout responsive to an alignment of a plurality of discrete symbols associated with a winning combination along a selected payline (Col. 9, Lines 44 to 48; Col. 9, Lines 9 to 18; 1 to 5 frames exposed for active play, Abst.; Col. 4, Line 65 to Col. 5, Line 9). '581 teaches a plurality of different first discrete symbols being associated with respective discrete symbol positions (Fig. 5, 7:63-67). The new limitations of Claim 9 are obvious for the reasons outlined in the rejections of Claims 1 and 3.

6. As to Claim 18: '581 teaches a method of conducting a slot game on a slot machine controlled by a processor (Abst., Col. 9, Lines 44 to 48). '581 receives a wager from a player (Col. 1, Lines 12 to 20). '581 rotates a plurality of reels, each of the reels each comprising a reel strip bearing a plurality of discrete symbols and a

continuous graphical element extending between adjacent ones of the discrete symbols such that the discrete symbols are thematically unified by the graphical element (Abst.; simulated movie reel (video reel), Fig. 3; looping reels, Fig. 8; Col. 2, Lines 30 to 56).

'581 stops the reels to place a portion of each reel in visual association with a display area (Col. 9, Lines 44 to 48; Col. 9, Lines 9 to 18; 1 to 5 frames exposed for active play, Abst.). '581 provides a payout responsive to an alignment of a winning combination of discrete symbols along a payline in the display area (Col. 4, Line 65 to Col. 5, Line 9).

The new limitations of Claim 18 are obvious for the reasons outlined in the rejections of Claims 1 and 3.

7. As to Claim 25: '581 teaches a method of conducting a slot game on a slot machine controlled by a processor (Abst., Col. 9, Lines 44 to 48). '581 receives a wager from a player (Col. 1, Lines 12 to 20). '581 rotates a video reel, the video reel bearing a plurality of discrete symbol positions and a continuous graphical element extending between adjacent ones of the discrete symbol positions such that the discrete symbol positions are unified by the graphical element (Abst.; simulated movie reel, Fig. 3; looping reels, Fig. 8; Col. 2, Lines 30 to 56). '581 moves a discrete symbol between adjacent ones of the discrete symbol positions as the video reel is rotated (player adjusting distance between frame positions, Fig. 8, Col. 8, Lines 17 to 36, appears to change positions of symbols relative to frame positions without changing order of symbols on virtual reel). '581 determines a payout based on the movement of the discrete symbol between the adjacent ones of the discrete symbol positions as the

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video reel is rotated (Col. 4, Line 65 to Col. 5, Line 9). The new limitations of Claim 25 are obvious for the reasons outlined in the rejections of Claims 1 and 3.

8. As to Claim 4: The discrete symbols of '581 are superimposed over the graphical element (Fig. 3, Col. 5, Line 66 to Col. 6, Line 17).

9. As to Claim 5: One of the graphical elements of '581 is a trial in the form of a railroad (Fig. 5, Col. 7, Lines 63 to 67).

10. As to Claim 7: '581 teaches the reel being simulated on a video display (Col. 2, Lines 30 to 46).

11. As to Claim 10: '581 teaches means for rotating and stopping the reel and the discrete symbol to place a portion of the reel in visual association with a display area (1 to 5 frames exposed for active play, Abst.).

12. As to Claim 11: '581 teaches the discrete symbol being superimposed over the graphical element (Fig. 3; Col. 5, Line 66 to Col. 6, Line 17).

13. As to Claim 12: One of the graphical elements of '581 is a trial in the form of a railroad (Fig. 5, Col. 7, Lines 63 to 67).

14. As to Claim 14: '581 teaches the reel being simulated on a video display (Col. 2, Lines 30 to 46).

15. As to Claim 19: '581 teaches the discrete symbol being superimposed over the graphical element (Fig. 3; Col. 5, Line 66 to Col. 6, Line 17).

16. As to Claim 20: One of the graphical elements of '581 is a trial in the form of a railroad (Fig. 5, Col. 7, Lines 63 to 67).



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17. As to Claim 22: '581 teaches the reel being simulated on a video display (Col. 2, Lines 30 to 46).

18. As to Claim 24: '581 teaches the payout based, at least in part, on the portion of the reel associated with the display area (1 to 5 frames exposed for active play, Abst.; Col. 4, Line 65 to Col. 5, Line 9).

19. As to Claim 26: '581 teaches stopping the reel to place a portion of the video reel in visual association with the display area (1 to 5 frames exposed for active play, Abst.).

20. As to Claim 27: '581 teaches the discrete symbol being superimposed over the graphical element (Fig. 3; Col. 5, Line 66 to Col. 6, Line 17).

21. As to Claim 28: One of the graphical elements of '581 is a train in the form of a railroad (Fig. 5, Col. 7, Lines 63 to 67).

22. As to Claim 31: '581 teaches the discrete symbol being moved at a first velocity relative to the continuous graphical element (train embodiment with cars moving relative to tracks, Fig. 5, Col. 7, Lines 63 to 67).

23. As to Claims 38 to 40: '581 teaches second discrete symbols that can be different from first discrete symbols (Three Stooges or other themed symbols implemented in a bonus configuration, which would be different from the primary set of symbols, 6:66-17).

24. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over '581 and '200.

25. As to Claims 3 and 16: '581 teaches the discrete symbol being moved at a first velocity relative to the continuous graphical element (train embodiment with cars moving relative to tracks, Fig. 5, Col. 7, Lines 63 to 67). '581 does not, however, mention this happening during a bonus game. The applicant has not stated that having this happen during the course of a bonus game as opposed to only during the course of a base game solves any stated problem or is for any particular purpose. Moreover, it appears that '581, or the applicants' invention would function equally well with the limitation of moving the discrete symbol at a first velocity relative to the continuous graphical element in the course of a bonus game. '581 does teach bonus events in 6:66-7:17 in which the video reel feature is implemented as a bonus feature, so the game of '581, or the claimed invention, could function equally well as a primary or bonus game based on the teachings of '581. Further motivation can be found in the prior art as 6,210,275 teaches a racing game in which symbols move relative to a continuous graphical element in a bonus game (Fig. 1, Abst.). Analogous to '219, '275 awards the player according to the amount of motion relative to the continuous graphical symbol in that the player whose horse (symbol) crosses the finish line first wins the jackpot. Accordingly, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify '581 to include the limitation of moving the discrete symbol at a first velocity relative to the continuous graphical element in the course of a bonus game, as it is already done in the base game, and such a modification would have been considered a mere design choice which fails to patentably distinguish above '581.

26. Claims 6, 13, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '581 and '200.

27. As to Claims 6, 13, 21, and 29: '581 teaches the trail being in the form of a railroad as opposed to a road or a board game path. The applicants have not stated that having the trail in the form of a road or a board game path as opposed to a railroad solves any stated problem or is for any particular purpose. Moreover, it appears that '581, or the applicants' invention, would function equally well with the limitation of having the trail in the form of a road or a board game path as opposed to a railroad.

Accordingly, it would have been prima facie obvious to one of ordinary skill in the art to have modified '581 to have the limitation of having the trail in the form of a road or a board game path as opposed to a railroad, because such a modification would have been considered a mere design consideration which fails to patentably distinguish above '581.

28. Claims 8, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over '581 and '200.

29. As to Claims 8, 15, and 23: '581 does not mention the reel being physical and being driven by a stepper motor. Such a modification would however been obvious to one of ordinary skill in the art at the time of invention in light of Hagiwara (U.S. patent 4,838,552 A). '552 teaches slot reels made from actual film strips (Figs. 6 and 7, Col. 6, Lines 53 to 67). Fig. 6 of '552 teaches a light source 58, very similar to the mechanism

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found in an actual film projector. '581 teaches the slot reel being a virtual movie reel (Abst.; Fig. 3; Col. 5, Line 66 to Col. 6, Line 17). Such a modification using a physical reel to simulate a movie reel would be obvious since actual movies in the film format are played on film projectors. Motivation for using a stepper motor to drive the physical reel with a stepper motor can be found in Davies (UK patent publication GB 2 330 936 A, Figs. 1d-f, Page 5, Lines 9 to 14), which displays slot reels using physical reels using strips of actual film driven by stepper motors. Stepper motors to drive slot reels were widely known in the gaming art at the time of invention. The advantage of this motivation would be to provide a realistic movie projector-like physical implementation of the slot reels for the movie film embodiment of '581, such a modification would appeal to game players familiar with the Three Stooges, Marx Brothers, and Godzilla themes of '581 (5:66 to 6:17), most of whom will be old enough to have actually seen a film projector in real life, unlike younger players who may have only seen a VCR or a DVD player. Further motivation can be found in Nevada gaming regulation 14.025 requiring themes to appeal to players only 21 years of age or older.

30. Claims 17 and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over '581 and '200 in view of Kojima (U.S. patent 5,265,889 A).

31. As to Claims 17 and 33: The previous rejections of Claims 8 and 15 are incorporated by reference, as they show the limitation of a physical reel comprising a strip are obvious in light of '581 and '200. '581 discloses all of the limitations of Claims 17 and 33, but lacks specificity as to a payout accumulating based on each discrete

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symbol position traveled by the discrete symbol. '889, however, discloses the score accumulating based on the distance of a discrete symbol traveled in relation to a continuous graphical element (Col. 2, Lines 53 to 58). The discrete symbol takes the form of a car (6) and the graphical element takes the form of a road (7) (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the distance-based score accumulation of '889 to the game of '581. '581 has a video reel strip embodiment (simulated movie film strip, Fig. 3) and an obvious physical reel strip modification as demonstrated in the rejections of Claims 8 and 15. '581 also has an embodiment in which a vehicular discrete symbol, a train, moves relative to a continuous graphical element in the form of a railroad track (Fig. 5; Col. 7, Lines 63 to 67, cars aligning with winning paylines). '581 also teaches a game of pseudo-skill in which the discrete symbol in the form of a vehicle traveling along a path, and the player is allowed to attempt to stop the vehicle at a desired point on the path (Col. 11, Lines 12 to 20). The advantage of this combination would be to provide a further way for a player to accumulate points, as opposed to merely winning points for winning paylines. This would be a very concrete way for the player to accumulate points, as it is very visible to the player the relative motion of the simulated locomotive or other vehicle throughout the game.

### ***Response to Arguments***

32. Applicant's arguments with respect to Claims 1, 3-15, 17-29, 31, 33 and 38-40 have been considered but are moot in view of the new ground(s) of rejection. The

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applicants keep amending the claims only to run into a new type of game (4th RCE).

The examiner believes that citing in the independent claims that moving the second symbol at a second velocity and the continuous graphical element at a first velocity in the same direction while the second symbol moves at such a speed that it is always visible to the player on the screen (such as in '219 2:65-3:5) in addition to the cited limitations would make the independent claims allowable (spec. 6:25-7:6). '219 and like references would teach away from combination with '200 and like references as '219 requires player input and '200 randomly determines who will win first. Walker (U.S. patent 6,579,178 B1) reads on both moving a second discrete symbol relative to the continuous graphical element and determining the award being related to a degree of movement and independent of any payline (Claim 1, 5/2/2007) and rotating the continuous graphical element at a first velocity and a discrete symbol at a second velocity (Claim 1, 8/17/2006). The two concepts independently are simply too broad to be novel or non-obvious by themselves and really need to be combined to make claims inventive. The thematic unity has no patentable weight as it is non-functional descriptive language (in re Gulack, ex parte Carver, in re Lowry, ex parte Breslow, MPEP 2106.01). The thematic unity would have patentable weight if, for example, the continuous graphical element were cited as a race track and the second symbols, the cars of the applicants' specification or the references cited, were cited as starting at a starting line and stopping at a finish line. The examiner respectfully disagrees with the applicants as to the claims' condition for allowance.

**Conclusion**

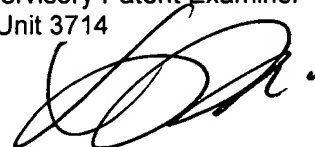
33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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